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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,477	12/11/2003	David C. Hovda	S-16	2479
21394	7590	11/16/2007		
ARTHROCARE CORPORATION 7500 Rialto Boulevard Building Two, Suite 100 Austin, TX 78735-8532			EXAMINER PEFFLEY, MICHAEL F	
			ART UNIT 3739	PAPER NUMBER
			NOTIFICATION DATE 11/16/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocure.com

**Office Action Summary**

Application No.

10/735,477

Applicant(s)

HOVDA, DAVID C.

Examiner

Michael Peffley

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 8, 10, 11, 13-23 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10, 11, 13-23 and 26 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/7/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/25/07</u> . | 6) <input type="checkbox"/> Other: _____  |

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2007 has been entered.

***Information Disclosure Statement***

Applicant should note that the large number of references in the attached IDS have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. **See MPEP 609.05(b)**. Applicant is requested to point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

***Claim Objections***

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4 recites the exact same limitations that have been added to independent claim 1 and therefore fail to further limit the subject matter.

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Claim 2 is objected to because of the following informalities: "an access device" (line 1) should be changed to "the access device" in view of the amendment to claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is unclear in that it contradicts with the amendment to claim 1. Claim 1 clearly recites viewing an interior of a disc, then treating the interior of the disc. Claim 5 calls for treating the disc prior to viewing which is contradictory to the language of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 8, 10, 11, 13-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharps et al (6,602,248) in view of the teaching of Banko (3,659,607).

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Sharps et al disclose a device and method for treating an intervertebral disc.

Access to the disc is gained by advancing a needle device (928 – Figures 41 and 44) into the disc. Sharps et al disclose treatment of the disc using a treatment device (918) that is inserted into the disc and provides RF energy to treat the disc tissue. The device may include a both poles of the RF electrode system on the treatment device, or only one pole on the device with the return pole located elsewhere within the disc (col. 56, lines 55-67). Sharps et al also disclose providing fluid to the disc space (col. 56, lines 1-15), as well as the use of various imaging techniques to view the disc space prior to and during treatment. Among the imaging techniques is the insertion of a fiber optic into the disc space through ancillary probe member (938). There is no specific teaching that a single access device is used to provide insertion of the optical fiber to view the tissue, followed by removal of the optical fiber and insertion of the treatment tool to treat tissue as recited in the instant claims.

The examiner maintains that the use of a single access device, which would minimize the trauma to the disc tissue, to perform both viewing and treating functions would be an obvious alternative methodology for one of ordinary skill in the art. In particular, Banko teaches that it is known to use a single access device, in this case for access ocular tissue, through which a variety of imaging and treatment devices may be individually advanced to perform a given procedure (col. 1, lines 45-60).

The specific steps of intermittently viewing and then treating tissue is deemed to be an obvious methodology for accurately and successfully performing the procedure. That is, one of ordinary skill in the art would obviously recognize the advantages of

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intermittently viewing the treatment area to assure the proper tissue is being treated and to ensure the treatment has been successfully performed.

The use of a single access device for selectively imaging and treating disc tissue while minimizing the trauma to the disc in the Sharps et al system would have been an obvious alternative methodology for one of ordinary skill in the art, particularly since Banko teaches that it is generally known to use a single access device for selectively inserting various imaging and treatment devices.

### ***Response to Arguments***

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/  
Primary Examiner  
Art Unit 3739

/mp/  
November 1, 2007